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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,889	01/16/2002	Allan R. Schwartz	99P1040US01	7936

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PACESETTER, INC  
15900 Valley View Court  
Sylmar, CA 91392-9221

EXAMINER

OROPEZA, FRANCES P

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 05/04/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/051,889

Applicant(s)

SCHWARTZ ET AL.

Examiner

Frances P. Oropesa

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/18/04 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. In the amendment filed 2/18/04, the Applicant amended the claims to overcome the rejection of record hence a new rejection is established in the subsequent paragraphs.

***Claim Rejections - 35 USC § 102***

2. Claims 1, 2, 4-12, 14 and 16-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Er et al. (US 5971341).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Er et al. disclose an implantable device with a parameter storage unit (122), a receiver (116), an external programmer (100), and a controller (118) (figures 2, 4A; col. 3 @ 65 – col. 4 @ 20; col. 6 @ 6-22; col. 7 @ 40-64; col. 8 @ 66 – col. 9 @ 65; col. 11 @ 50-52; col. 19 @ 32-46). The controller is responsive to a reset signal from the external programmer to change the operating configuration/ programming state containing all the parameters (mode, base rate, A-V delay and other accepted parameters such as rest rate, maximum tracking rate, maximum sensor rate) (col. 21 @ 35-51). The operating configurations are transmitted to the programmer (col. 19 @ 37-46).

As to claim 2, a current state pointer is disclosed (col. 10 @ 19-22).

As to claims 5, 10 and 14, at least three sets of parameters representative the three programming states are disclosed including dual chamber and single chamber atrial and ventricular modes (col. 12 @ 19-26; col. 11 @ 5-10).

As to claims 12 and 14, the difference between the configurations/ programming states are displayed (figure 13; col. 22 @ 5-6).

As to operating configurations and programming states, the operating configuration and the programming state are both read as collections of operating parameters. The Applicant appears to assert in the 2/18/04 amendment that programming states are a collection of parameters that are established and do not need to be modified, hence the operating states of Er et al. do not qualify as programming states. It is noted however that the instant specification discusses establishing a programming state and then selectively modifying the parameters to create a new programming state (Specification – page 3, lines 7-12), hence undermining the notion that programming states are established unmodified collections of parameters. The operating states of Er et al. are read as programming states.

3. Claims 1, 2, 4-11 and 16-22 rejected under 35 U.S.C. 102(e) as being anticipated by Alt et al. (US 6073049).

Alt et al. disclose an implantable device (10) with a parameter storage unit (memory – col. 8 @ 60-65), a receiver (figure 1 – antenna and circuitry; col. 9 @ 42-46), an external programmer (25), and a controller (15) (figure 1; col. 8 @ 54-65). The controller is responsive to a reset signal from the external programmer to change the programming states containing all

the parameters (mode and other accepted parameter criteria such as base rate, A-V delay rest rate, maximum tracking rate, maximum sensor rate) (col. 11 @ 9-11). The programming states are transmitted to the programmer (col. 9 @ 29-46; col. 11 @ 32-34).

As to claim 2, a current state pointer is disclosed (col. 11 @ 41-48).

As to claims 5, 10 and 14, at least three sets of parameters representative to three programming states are disclosed including dual chamber and single chamber bradycardia and pathological tachycardia modes (col. 13 @ 54-58).

As to operating configurations and programming states, the operating configuration and the programming state are both read as collections of operating parameters. The Applicant appears to assert in the 2/18/04 amendment that programming states are a collection of parameters that are established and do not need to be modified, hence the operating states of Alt et al. do not qualify as programming states. It is noted however that the instant specification discusses establishing a programming state and then selectively modifying the parameters to create a new programming state (Specification – page 3, lines 7-12), hence undermining the notion that programming states are established unmodified collections of parameters. The operating states of Alt et al. are read as programming states

***Allowable Subject Matter***

4. Claims 3, 13 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Statutory Basis*

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Friday from 9 a.m. to 5 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the

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organization where this application or proceeding is assigned is (703) 872-9306 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist at telephone number (703) 308-0858.

Frances P. Oropeza  
Patent Examiner  
Art Unit 3762

*380*  
*5/2/04*

*Angela D. Sykes*

ANGELA D. SYKES  
SUPERVISORY PATENT EXAMINER  
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